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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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EXAMINER

MILLER, BENA B

ART UNIT

PAPER NUMBER

3725

MAIL DATE

DELIVERY MODE

09/18/2008

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 09/845,999	Applicant(s) DEMASI, DOUGLAS D	
	Examiner Bena Miller	Art Unit 3725	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 20 May 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 21-42 and 44-51 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 21-42 and 44-51 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 21-24, 34, 36-38, 40-42, and 44-49 are finally rejected under 35 U.S.C. 102(b) as being anticipated by Woolley (US Patent 5,100,354).

The device of Woolley reads on the limitations of the claimed invention including: Regarding claims 1 and 38, a wing section (combination 37, 31 and 39) and a fuselage or tail section (13) for on water and flying through the air aerodynamically and separable into two sections (fig. 9—first section and second section—board 13), comprising a first section constituting the wing (fig. 9) of the product and deriving its lift in flight from forces resulting from its motion through air and independently usable as a rideable element, and a second section constituting the fuselage or tail section (fig. 2 and 5) of the product and independently usable as a surfboard and the first section having longitudinally- extending control fins on its underside (41 and 43). In reference to "rideable element", it should be noted applicant has not claimed structure to read over the broadest interpretation of a "rideable element" (i.e., any structure that can support a user). Further, the wing section of Woolley will fly through the air depending on the speed of the boat, the lift against the water and the weight of the user. It should be also noted the second section can be used independently as a surfboard since the board is capable of being disconnected from the wing section as seen in figure 9.

Regarding claims 22, 23, 40, 46 and 47, the wing section has control elements (109 and 110) on its upper surface and the tail section has control elements (27) on its upper surface.

Regarding claims 24, 41 and 42, the wing section has longitudinally extending fins on its underside (41 and 43) and a central longitudinal fin on the underside of the first section (41 and 43).

Regarding claim 34, Woolley further teaches a device comprising a central front end portion (39), a wide rearward portion (33), and a central rearward portion having a rearward facing opening (109 and 110) for receiving an attachment rendering the body the wing of a recreational vehicle.

Regarding claim 36, Woolley further teaches fins that extend longitudinally on its underside (41 and 43).

Regarding claims 44 and 45, Woolley further teaches a product having wings (33 and 39) comprising first parts constituting wings of the product (fig.9) and a tail section (11) and a second part constituting the tail section (11--fig. 5 and 6).

Regarding claims 48, Woolley further teaches first parts constituting the wings have longitudinally extending fins on their undersides (41 and 43).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 25-33, and 49-51 are finally rejected under 35 U.S.C. 103(a) as being unpatentable over Woolley in view of Saghri (US Patent 5,498,184).

Woolley teaches most of the elements of the claimed invention including, generally thin and flat elongated portion (11), a wider rear end (13) on the elongated portion, control elements on the upper surface (27) and a non-slip board (col. 5, lines 60-63). However Woolley fails to teach the tail section having longitudinally extending fins on the upper side of the product, thin fins extending upwardly and downwardly on the board and an inflatable bladder. Saghri teaches a board 30 having longitudinally extending fins (44 and 48) on the upper side for the purpose of enhancing the propulsive capability and stability of the board. It would have been obvious to one of ordinary skill in the art to incorporate longitudinally extending fins, as suggested by Saghri, on the upper side of Woolley, for the reasons set forth above. Further, Saghri further teaches that it is well known in the prior art to attach mechanical devices (i.e., fins) to the underside of the board so as to provide an obstacle against which rushing water impacts for propelling the board (see, col. 1, par. 5). Therefore, it would have been obvious to have the longitudinally extend fins extend downwardly on the board of Woolley for the reasons set forth above.

Also, Saghri teaches that it is well known to provide a recreational board with inflatable material (col. 6, par. 4). It would have been obvious one having ordinary skill in the art to use inflatable material as taught by Saghri for the device of either Woolley for the purpose of conveniently storing the device when deflated.

Claims 35 and 39 are rejected under 35 U.S.C. 103(a) as being unpatentable over Woolley in view of Schlueter (US Patent 3,320,625).

Woolley teaches most of the elements of the claimed invention except for a tow. Schlueter teaches that it is well known to provide a tow attached to the surface of a surfboard for towing the board. It would have been obvious to one of ordinary skill in the art to incorporate a tow, as suggested by Schlueter, in the device of Woolley for the reasons set forth above.

Response to Arguments

Applicant's arguments filed 05/20/08 have been fully considered but they are not persuasive. Applicant argues on page 8 of the Remarks that Woolley fails to teach the wing section "deriving its lift in flight from the reaction forces resulting from its motion through air. The examiner disagrees. Woolley teaches that when the device is in motion, the fluid striking the blade attached to the bottom of the device creates a high pressure region below the blade and low pressure above it, resulting in lift that raises the device out of the water (col. 1, par. 3). Therefore, the examiner maintains the device Woolley meets the claimed limitations. Further, the applicant argues on page 9 of the Remarks that Woolley does not teach a wider rear end and that wider rear end 13 is narrower. The examiner disagrees. The examiner contends that Woolley clearly shows in figure 5 a wider rear end of the elongated portion 11.

In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention

where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). Sahri and Schlueter disclose a similar device that teaches the claimed limitations which in combination would cure the deficiencies of the device of Woolley. Therefore, the examiner maintains the combination of the prior art would meet the claimed invention.

For the reasons set forth above, this Office Action is made Final.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Bena Miller whose telephone number is 571.272.4427. The examiner can normally be reached on Monday-Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Derris Banks can be reached on 571-272-4419. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Bena Miller/
Primary Examiner, Art Unit 3725
September 14, 2008